



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,967	02/16/2001	Andrey Jivsov	NAI-1 (99.077.01)	5439

7590

08/10/2004

Edward A. Pennington, Esq.
SWIDLER BERLIN SHEREFF FRIEDMAN, LLP
3000 K Street
Suite 300
Washington, DC 20007

EXAMINER

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 08/10/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,967

Applicant(s)

JIVSOV, ANDREY

Examiner

Matthew B Smithers

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-26 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed April 18, 2001 has been placed in the application file and the information referred to therein has been considered as to the merits.

Claim Objections

Claim 16 is objected to because of the following informalities: The preamble sets out to define what is comprised in a sender's messaging, however, the elements within the body of the claim (specifically the processor and memory) are elements that further define a system or an apparatus and not a messaging. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

~~The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.~~

Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and

bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 15 and 16 both recite the broad recitation of a memory to store instructions and data, and the claims also recite the memory to store an encrypted message that was received from a sender; one or more instructions to decrypt an encrypted transaction identifier to provide a decrypted transaction identifier; one or more instructions to generate a request for an encrypted session key based on the transaction identifier; one or more instructions to send the request to an arbiter; one or more instructions to receive the encrypted session key; one or more instructions to decrypt the encrypted session key to provide a decrypted session key; and one or more instructions to decrypt the encrypted message using the decrypted session key which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Art Unit: 2137

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17, 18 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a series of steps or instructions to for receiving and responding to a request associated with a transaction identifier and a session key. The claim does not show any pre-computing or post computing activity performed by a computer using the series of steps or instructions. The claim limitation is merely a set of instructions does not provide a tangible result.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, and 10-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,710,816 granted to Stork et al and further in view of U.S. patent 6,009,173 granted to Sumner.

Regarding claims 1, 10, 12, 13, 14, 15, 16, 17, 20, 22, 23, 24, Stork teaches ensuring receipt of voicemail messages (electronic messages) where the receiver send a certification request message to a designated location (third party) in order to obtain information to enable decryption of the encrypted voice

Art Unit: 2137

message transmitted by a sender (see column 1, lines 43-55 and column 3, lines 31-65). In performing these steps a sender/designated location is able to certify that a recipient of a message has accessed the encrypted message once it has recorded the recipient's request for decryption (see column 3, line 66 to column 4, line 4). Stork further teaches generating a transaction identifier associated with the message (i.e. message identification information) and encrypting the message using a key unique to the particular message (session key)(see column 2, lines 48-65 and column 4, lines 61-64). Stork fails to specifically teach encrypting the session key by use of a public key. Sumner teaches a secure messaging system where a message is first encrypted by a session key and then the session key is encrypted with a recipient's public key prior to transmitting the encrypted message to a recipient (see column 1, lines 35-40 and column 3, lines 34-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Sumner's method of secure messaging with Stork's method for ensuring receipt of electronic messages in order to prevent eavesdroppers from mounting attacks on the message by preserving the integrity of the session-key-associated-with-the-encrypted-message.

Regarding claims 2, 11, 18, 19, 25, and 26 Stork as modified teaches the request comprises the transaction identifier (messages identification information) and recording the transaction identifier was received (see Stork column 3, line 66 to column 4, line 4 and column 4, lines 55-64).

Regarding claim 3, Stork as modified teaches the request comprises the transaction identifier in unencrypted form such that the arbiter does not perform

Art Unit: 2137

any cryptographic operations to extract the transaction identifier from the request (see Stork column 3, line 66 to column 4, line 4 and column 4, lines 55-64).

Regarding claim 4, Stork as modified teaches the encrypted message is delivered directly from the sender to the recipient (see Stork column 1, lines 44-48).

Regarding claims 5, 6 and 21, Stork as modified teaches the notifying the sender of the certification request (see Stork column 3, line 66 to column 4, line 4 and column 4, lines 55-64).

Regarding claim 7, Stork as modified teaches (see Stork column 3, line 66 to column 4, line 4 and column 4, lines 55-64).

Allowable Subject Matter

Claims 7, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject-matter:

With respect to claim 7, the cited prior art fails to specifically teach the request is repeatedly transmitted for a predetermined period of time by the recipient until the encrypted session key is received.

With respect to claim 8, the cited prior art fails to specifically teach signing the decrypted transaction identifier, and transmitting the request comprises sending the signed decrypted transaction identifier to the arbiter.

Art Unit: 2137

With respect to claim 9, the cited prior art fails to specifically teach decrypting, using the recipient's private key, the transaction identifier from the encrypted transaction identifier to provide a decrypted transaction identifier; signing the decrypted transaction identifier and a nonce associated with that recipient; and sending the signed decrypted transaction identifier and the nonce to the arbiter.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Kara (US 6,158,003) discloses a system for certifying electronic transmissions between a sender and a recipient.

B. Danieli (US 6,510,513) discloses a security services system where a trusted arbitrator logs transactions between two clients.

C. Smith et al (US 6,532,543) discloses an auditable secure network where each transaction is logged and maintained for verification purposes.

~~D. Hallin et (US 6,754,661) discloses a system for maintaining evidentiary~~
records of transactions within the system.

E. Simmons, "A Protocol to Provide Verifiable Proof of Identity and Unforgeable Transaction Receipts", discloses a verification scheme where arbiters verify certified receipts of transactions that occurred within a network.

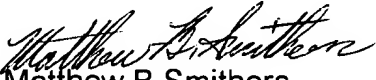
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone

Art Unit: 2137

number is (703) 308-9293. The examiner can normally be reached on Monday-Friday (9:00-5:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T Caldwell can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew B Smithers
Primary Examiner
Art Unit 2137
